REMARKS

By the present amendment, claims 23, 37, 42, 43 and 44 are amended. No new matter has been added by those amendments. Claims 23-44 are pending in the application. Re-examination and reconsideration of the application, as amended, are requested.

Claims 37 and 42 are objected to as having a minor informality (missing period). Those claims are amended herein to add a period. Accordingly, it is requested that the objection to claims 37 and 42 be withdrawn.

Claims 23, 24, 26, 32-34, 36, 41, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimura et al. (EP 0705036). Claims 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. These rejections are respectfully traversed.

Independent claim 23 is amended for purposes of expediting the prosecution and allowance of the application. As amended, claim 23 recites that "the user selectable symbols are presented for display on the user display device simultaneous with the presentation of the program." In the example shown in Figure 7 of the present application, user-selectable symbols (icons) are displayed at the bottom of the screen 20, while the remainder of the screen is used to display a programme, including programme elements that correspond to selected symbols. (See page 11, line 17 to page 12, line 9 of the present application.) This allows a user to select symbols that correspond to classes of programme elements for presentation in the programme that is being <u>simultaneously</u> displayed with the symbols. For example, a user may view a whole programme, select symbols (icons) to view highlights of that programme or jump through sequences of highlights in any desired order. (See page 12, lines 23-35 of the present application.) Thus, while viewing the programme, the user may simultaneously select symbols to skip through parts of the programme to look for sections of interest, or periodically review interesting parts of the programme (See page 12, lines 26-29 of the present application).

Yoshimura et al. describe displaying program schedules and tables. However, Yoshimura et al. do not describe or suggest displaying user-selectable symbols that represent classes of programme elements of a programme <u>simultaneous with</u> the display of the programme. Yoshimura et al.'s schedules and tables are used to search for and select programs for <u>subsequent</u> viewing or

storage. Such schedules or tables are not displayed when a program is displayed. Instead, Yoshimura et al.'s schedules or tables are displayed on the user's screen 75D in response to the operation of a menu button 94 on the remote commander 90. (See paragraph 0116 and Figure 9 of the Yoshimura et al. reference.) Yoshimura et al. show schedules and tables that occupy the entire screen 75D, leaving no room to simultaneously display a program (see Figures 9 and 15-19 of Yoshimura et al.). Thus, Yoshimura et al. teach away from simultaneously displaying symbols (representing programme elements) and the programme. Accordingly, claim 23, as amended herein, is patentably distinguished over Yoshimura et al.

For similar reasons, it is also submitted that independent claims 43 and 44 are patentably distinguished over the Yoshimura et al. reference. For example, claim 43 recites that "the symbols are displayed to the operator of a display device simultaneous with the presentation of programme elements by the display device." Similarly, claim 44 recites that "the symbols are displayed to the user simultaneous with the presentation of programme elements on the display device."

Furthermore, in response to the previous Office Action, Applicant pointed out that independent claim 23 recites, among other features, "generating a progremme for presentation on a user display device by selecting at least one programme classification code and presenting programme elements associated with said at least one programme classification code." Applicant explained that, in the claimed method, a new (or edited) programme is generated by presenting programme elements associate with at least one selected programme classification code.

In the latest Office Action, the Examiner stated that the feature of "new" or "edited" programming is not recited in any of the claims. Applicant did not intend to focus attention to the phrase "new (or edited)" and apologizes for the unintended focus. Rather, Applicant was intending to direct attention to the feature that generating a programme (a resulting program, also referred to as the "new or (edited)" programme) involves presenting programme elements (plural) associated with at least one selected programme classification code. Thus a plurality of "programme elements" are presented within a (single) generated programme. The programme elements used in the resulting generated programme are associated with at least one selected programme classification code.

For example, if the programme is a sports event such as a football game, selected programme elements may be displayed within the same sports event programme. In this regard, selected programme elements (for example, portions of the game or highlights that are of special interest to the user, such as passing plays or scoring plays) may be selected and displayed or re-played during less interesting portions of the same game. Thus, a programme (e.g., of a football game) may be generated to include plural programme elements (e.g., showing interesting plays) within the same programme, where the programme elements are selected by selecting at least one programme classification code. (e.g., See page 8, lines 1-20 of the present application).

In contrast, Yoshimura et al describe a program information display system in which a user may select individual pre-set programs or subprograms shown on a schedule for display or for reserving to display at a later time (see paragraph 0191 of Yoshimura et al.). While Yoshimura et al describe the ability to select individual pre-set programs or program elements and designate an order to play the selected programs or program elements, Yoshimura et al do not fairly teach or suggest generating a programme (i.e., generating a resulting programme) having a plurality of programme elements that correspond to a selected programme classification code. Rather Yoshimura et al. simply allows a user to select individual, discrete programs or subprograms from a program schedule or table and play the selected programs or subprograms at user-selected times (to provide a time-shifting function). This is not the same as generating a programme by presenting plural programme elements in a (single) resulting (generated) programme. Yoshimura et al. neither describe nor suggest generating a resulting programme from the pluraiity of discrete, individual programs or subprograms that appear on Yoshimura et al.'s program schedule table.

The Examiner pointed out that the claimed generated programme is not truly "brand" new, because it is reproduced or regenerated from storage. It is correct that the claimed feature of "generating a programme ..." could involve presenting pre-recorded or reproduced programme elements. However, the reference to a "new (or edited)" programme was intended to refer to the *resulting* programme that is generated by presenting plural programme elements combined in a single generated programme (even if some or all of the individual elements were pre-recorded). As noted above, Yoshimura et al. do not fairly teach or suggest the generation of a programme from a plurality of programme elements including programme elements that are associated with a selected classification code. Instead, Yoshimura et al describe displaying pre-set programs or sub-programs

individually, without regard to the generation of a single resulting programme. Accordingly, claim 23 is believed to be further patentably distinct from Yoshimura et al.

For similar reasons, independent claims 43 and 44 are also believed to be further patentably distinct from Yoshimura at el. It is noted that claim 43 includes "means for selecting at least one programme classification code" and "means for generating a programme by presenting programme elements associated with the selected said at least one programme classification code ..." Claim 44 recites "a user terminal having a controller for generating a programme by presenting programme elements associated with at least one selected programme classification code." Thus, claims 43 and 44 are believed to be patentably distinguished from Yoshimura et al. for reasons similar to the reasons expressed above with respect to the feature of "generating a programme for presentation on a user display device by selecting at least one programme classification code and presenting programme elements associated with said at least one programme classification code," as described above with respect to claim 23.

Also, dependent claims 24, 26, 32-34, 36 and 41 are believed to be patentably distinct over the Yoshimura et al. reference at least for reasons as discussed above with regard to the indpendent, parent claim (claim 23). In addition, it is noted that claim 26 recites that the method comprises "further classifying program elements by a subjective assessment of value." (underline added for emphasis) Thus, claim 26 involves a "further" classification (further to classifying on the basis of content as recited in parent claim 23), where the "further" classification is based on subjective value. In other words, claim 26 involves classifying by content and further classifying by subjective value. Claim 41 recites that the classification code represents a subjective indication of the value of programme elements in the class.

The Examiner stated that each program element in Yoshimura et al. is classified by a subjective assessment (i.e., by movie, type of movie, musical, music group member), citing Figs 208. However, the cited portions of the Yoshimura et al. reference do not describe or suggest "subjective value" assessments. Instead, Yoshimura et al. simply categorizes programs by type, title, artist or production company. The title, type or artist of a movie or music piece does not take into account a subjective value assessment. According to Yoshimura et al., a song could be classified by its title (e.g., "Smoke On The Water"), type (e.g., rock-and-roll), artist (e.g., Deep

-10-

Purple), or by production company (Sony). However, none of those classifications relate to a subjective value assessment. One cannot tell value from title, type, artist or production company. For example, different rock-and-roll songs may have different relative values to an individual. The classification of a song as "rock-and-roll" would not indicate a subjective value of the song and, thus, would not be a classification by subjective value. Accordingly, dependent claims 26 and 41 are believed to be further distinguished over the Yoshimura et al. reference.

In addition, claim 35 recites that "generating a programme comprises combining programme elements transmitted to the user's display device with pre-recorded programme elements stored on a data carrier in a memory device of the user's display device." Yoshimura et al. not only fails to describe or suggest generating a programme with plural programme elements (as discussed above with respect to claim 23), but further fails to describe or suggest generating a programme by combining transmitted and pre-recorded programme elements. As noted above, Yoshimura et al. describe selecting programs or subprograms for display or for reserving to display at a later time. Yoshimura et al. does not describe or suggest combining reserved programs or program elements with transmitted programme elements to generate a programme therewith.

The Examiner stated that "[a]lthough Yoshimura does not specify that the stored program segments are combined with the received program elements, it would have been clearly obvious to one of ordinary skill in the art to present the entire program to the user if he so wishes, in the instances when the user decides to view the complete program rather than just segments, or in instances when another members of the household perfer to watch the entire program ..." However, even if Yoshimura et al were to display an entire program, the program would be displayed either entirely from memory or entirely as it is broadcast. Yoshimura et al. neither describe nor suggest generating a programme by combining both transmitted programme elements and pre-recorded programme elements.

There is no disclosed or suggested reason or motivation in Yoshimura et al. to pre-record some (but not all) elements of a programme, receive other transmitted programme elements and then combine the transmitted and pre-stored programme elements into a resulting programme. Instead, Yoshimura et al. teach to transmit entire programs or subprograms at scheduled times and

display or reserve selected entire programs or subprograms for display at later times. Accordingly, it is believed that dependent claim 35 is further patentably distinguished from Yoshimura et al.

Claim 37 recites that "generating a programme for presentation on a user display device further comprises repeating the presentation on the user display device of at least one transmitted programme element." Yoshimura et al. neither describes nor suggests generating a programme that includes repeating presentation of a programme element. The Examiner stated that "it would have been obvious to display any program a second, third, fourth, and other times as so desired by the user ..." However, repeating a program multiple times is not the same as generating a programme, where the generated programme includes repeating programme elements. In the claimed method, a single programme includes repeating programme elements. In the proposed use of Yoshimura et al.'s system, multiple repeated programs are generated (not a single programme that includes repeating programme elements). Accordingly, it is believed that dependent claim 37 is further patentably distinguished from Yoshimura et al.

Claims 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. in view of Nagasaka et al. This rejection is respectfully traversed.

Claims 27-31 are dependent (directly or indirectly) on claim 23. Accordingly, for reasons as discussed above with respect to claim 23, it is believed that dependent claims 27-31 are patentably distinguished over the Yoshimura et al. reference.

Independent claim 23 (and, thus, dependent claims 27-31) are also believed to be patentably distinct from Nagasaka et al. Nagasaka et al provide icons for allowing a user to select a scene (or location) in a programme for resumption of viewing. (Col. 212, ll. 48-55.) However, Nagasaka et al does not disclose or suggest "generating a programme ... by selecting at least one programme classification code," wherein selecting a classification code comprises "displaying user selectable symbols" with "each symbol representing a class of associated programme elements ..." Nagasaka et al's icons do not represent a class of associated programme elements. Instead, Nagasaka et al employ user-selectable icons that represent discrete locations (or scenes) in a programme. Accordingly, the combination of Yoshimura et al. and Nagasaka et al. would not have led to the invention recited in claims 27-31.

-12-

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. in view of Klosterman et al. This rejection is respectfully traversed.

Claims 38 and 39 are dependent on claim 23. Accordingly, for reasons as discussed above with respect to claim 23, it is believed that dependent claims 38 and 39 are patentably distinguished over the Yoshimura et al. reference. Klosterman et al. do not address the above-noted deficiency of the Yoshimura et al. reference. Klosterman et al. neither describe nor suggest generating a programme, where a plurality of "programme elements" are presented within a (single) generated programme.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. in view of Kerman This rejection is respectfully traversed.

Claim 40 is dependent on claim 23. Accordingly, for reasons as discussed above with respect to claim 23, it is believed that dependent claim 40 is patentably distinguished over the Yoshimura et al. reference. Kerman does not address the above-noted deficiency of the Yoshimura et al. reference. Kerman also neither describes nor suggests generating a programme, where a plurality of "programme elements" are presented within a (single) generated programme.

Applicant notes with appreciation the Examiner's indication that claims 25 and 42 appear to be allowable over the prior art. Those claims are amended herein to be in independent form. Accordingly, it is submitted that claims 25 and 42 are in condition for allowance.

Applicant believes that the present application is now in condition for allowance. Favorable consideration of the application as amended is respectfully requested.

If, for any reason, the Examiner believes the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney at the Los Angeles telephone

number (310) 975-7963, to discuss any steps that may be needed to place the application in condition for allowance.

Respectfully submitted,

Date _August 19, 2003_

By _____

Ted Rittmaster
Attorney for Applicant
Registration No. 32,933

FOLEY & LARDNER
Customer Number: 23392

23392
PATENT TRADEMARK OFFICE

Telephone: (310) 975-7963
Facsimile: (310) 557-8475

-14-

015.596091.1